

Patent
SSV-61600



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

SHANNON MORRIS

Serial No.: 08/766,862

Filed: December 13, 1996

For: JEWELRY ORGANIZER

} Examiner: L. K. Bui

} Group Art Unit: 3208

AMENDMENT

Assistant Commissioner for Patents
Box Non-Fee Amendment
Washington, D.C. 20231

Sir:

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FEB 24 2004

OFFICE OF PETITIONS

In response to the Decision Concerning the Holding of Abandonment and Entry of Amendment dated April 5, 2001, please enter the following amendments in the above-identified application. Applicant also provides, as an attachment, a marked-up version of the changes made to the application by this Amendment.

IN THE CLAIMS

The claims have been amended as follows:

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1. (Twice amended) A jewelry organizer for holding jewelry such as rings, earrings, drop earrings, watches, bracelets, necklaces, and other strands of jewelry, comprising:

a body having an upper surface and a lower surface;
a knob protruding upwardly from the upper surface;
at least two compartments formed in the upper surface of the body for receiving jewelry, each compartment defined as an elongated channel surrounding the knob;
an outer rim around the periphery of the outermost compartment, the outer rim having a substantially flat surface; and
a recess in the lower surface of the body wherein the recess and the knob provide a means for a stackable configuration.

8. (Twice amended) A jewelry organizer for holding jewelry such as rings, earrings, drop earrings, watches, bracelets, necklaces, and other strands of jewelry, comprising:

a body having an upper surface and a lower surface;
a knob protruding upwardly from the upper surface, the knob having a diameter and height capable of receiving at least one finger ring over the knob;
at least one compartment formed in the upper surface of the body for receiving jewelry, each compartment defined as an elongated channel sized to receive a piece of jewelry;
a recess in the lower surface of the body; and
an outer rim around the periphery of the outermost compartment.

REMARKS

Applicant respectfully requests reconsideration of this application in view of the foregoing amendments to the claims and the following comments.

In the Decision Concerning the Holding of Abandonment and Entry of Amendment (the "Decision"), the holding of abandonment was vacated, the Amendment mailed November 29, 2001 was denied entry, and Applicant was provided an extendable time period of one month from date of the decision to take action in avoidance of abandonment. The Decision further provided that since a new ground of rejection was entered in an appeal decision for claims 1 and 8, amendments to claims 1 and 8 directed at the same subject matter as the appealed claims would be deemed appropriate as provided by 37 C.F.R. § 1.196(b) and MPEP § 1214.01.

Although the proper meaning and scope of the expression "the same subject matter" remains unclear, Applicant has amended claims 1 and 8 in a manner that she believes will be deemed consistent with the Decision, thereby rendering the rejections moot. These amendments are discussed below.

The Rejection of Claims 1 and 8 Under 35 U.S.C. § 102(b)

In the Decision on Appeal, the Board entered a new ground of rejection against independent claims 1 and 8 as allegedly anticipated by U.S. Patent No. 5,040,681 to Grusin, pursuant to 37 C.F.R. § 1.196(b). Specifically, claims 1 and 8 were rejected by the Board as allegedly anticipated by "a body 18" disclosed in the Grusin patent having "at least one compartment 34."

In brief, Grusin generally discloses an organizer container having an overall box-like configuration. The principal components of the container are a bottom tray 12, an intermediate tray 14, a top tray 16 and a cover 18. The trays 12, 14 and 16 and cover 18 are stackable one on top of another.

The cover 18 in Grusin is provided with an integrally formed knob 30 which extends slightly above the upper surface 32, and circumscribing the knob 30 is a recess 34. The purpose of the recess 34 is not to serve as a compartment for anything, but rather its purpose is to lend greater height to the knob 30, allowing for the cover 18 to have a relatively low overall profile. (*See col. 2, line 66 et seq.*) In other words, what the Board describes as a compartment in the cover 18 is actually a finger recess into which the fingers of the user can extend to grasp the knob 30, in effect giving the knob greater height.

It is further relevant to note that in Grusin, each tray 12, 14 and 16 has a centrally-located post member 42, 44 and 46 that is provided with an aperture 48, 50 and 52, respectively, in its upper surface, and the knob 30 is provided with an aperture 54 positioned immediately above the aperture 52 of the third post member 46. Each aperture 48, 50, 52 and 54 is dimensioned to permit the insertion of a finger through the center of the knob 30, the third post member 46, the second post member 44, and the first post member 42 to selectively allow the user to grasp and lift the cover 18 or one, two or all of the trays at once. (*See col. 3, line 14 et seq.*)

In response to the Board's rejection over Grusin, Applicant has amended claim 1 to replace the recitation of "at least one compartment" with "at least two compartments." Grusin's cover 18, of course, has only one recess, and because it only serves as a cover and not as an organizer, and further because the only purpose of the

recess is to lend greater height to the knob and not to serve as a compartment, there would be no motivation to have two recesses in Grusin's cover.

Similarly, claim 8 has been amended to distinguish over Grusin by requiring that the knob have a diameter and height capable of receiving at least one finger ring over the knob. Grusin's knob 30 is much too large to receive such a ring, and there would be no motivation to make the knob small enough for that task since it must be large enough to grasp and also to have an aperture to permit the insertion of a finger through the center of the knob.

Applicant respectfully contends that the above amendments are consistent with the Decision and are in compliance with 37 C.F.R. § 1.196(b) and MPEP § 1214.01 as they are directed at what apparently will be deemed by the U.S. Patent and Trademark Office as the "same subject matter" as the appealed claims.

Applicant also notes that none of the foregoing amendments should affect the allowability of the claims over any combination of the Martire, Grusin, Gatt or Coon patents, given the Board's rulings (i) that there would be no motivation to include a knob of any type in the upper surface of the Martire tray as taught by Gatt and Grusin, and (ii) that Coon does not cure the deficiencies of Martire, Gatt and Grusin. (*See* Decision at pages 6-8.) Accordingly, Applicant believes that the claims as amended define an unobvious advance over these prior art patents, whether taken singly or in any combination.

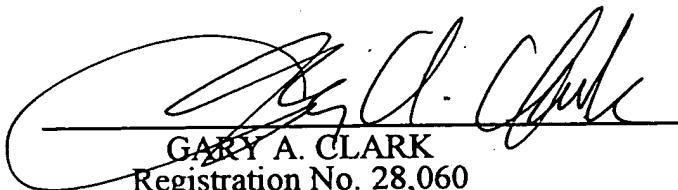
Conclusion

This application should now be in condition for a favorable action. A Notice of Allowance is respectfully requested. If the Examiner believes that a telephone conference with Applicant's undersigned attorney might expedite the prosecution of this application, the Examiner is invited to call at the telephone number indicated.

Dated: April 19 2001

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By



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Attachment: Version with Markings to Show Changes Made

VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. (Twice amended) A jewelry organizer for holding jewelry such as rings, earrings, drop earrings, watches, bracelets, necklaces, and other strands of jewelry, comprising:
a body having an upper surface and a lower surface;
a knob protruding upwardly from the upper surface;
at least [one compartment] two compartments formed in the upper surface of the body for receiving jewelry, each compartment defined as an elongated channel surrounding the knob;
an outer rim around the periphery of the outermost compartment, the outer rim having a substantially flat surface; and
a recess in the lower surface of the body wherein the recess and the knob provide a means for a stackable configuration.

8. (Twice amended) A jewelry organizer for holding jewelry such as rings, earrings, drop earrings, watches, bracelets, necklaces, and other strands of jewelry, comprising:
a body having an upper surface and a lower surface;
a knob protruding upwardly from the upper surface, the knob having a diameter and height capable of receiving at least one finger ring over the knob;
at least one compartment formed in the upper surface of the body for receiving jewelry, each compartment defined as an elongated channel sized to receive a piece of jewelry;
a recess in the lower surface of the body; and
an outer rim around the periphery of the outermost compartment.